



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,283	09/28/2001	James Morrow	10407/521	6806

30076 7590 04/19/2006

BROWN RAYSMAN MILLSTEIN FELDER & STEINER, LLP
1880 CENTURY PARK EAST
12TH FLOOR
LOS ANGELES, CA 90067

EXAMINER

PANDYA, SUNIT

ART UNIT PAPER NUMBER

3714

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

09/967,283

Applicant(s)

MORROW ET AL.

Examiner

Sunit Pandya

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 30-46, 48-50, 57-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 30-46, 48-50, 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giobbi (of record) in view of Marnell (US Patent No. 5,393,057).

Claims 1-4, 7, 14-20, 31-37, 39-45, 57 and 59: Marnell discloses a stand-alone gaming machine (col. 9:42-48), which includes a displays/screens displaying video content for a game of chance (col. 4: 17-29). However, Marnell is silent on the automatic reconfiguration happening in response to a trigger. Giobbi teaches a gaming system in which video content is capable of being reconfigured in response to various triggers such as time, play frequency (0050), wagered amount (0041& 0050) etc. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the feature of automatically reconfiguring the video content in response to a trigger as cited above as taught by Giobbi into the Marnell type system in order to provide automatic operation of subsequent gaming sessions, which would attract more players and enable use of the system without having to rely on some type of network communication interface.

Art Unit: 3714

Claims 5, 6, 46 and 58: Giobbi discloses allowing casino operators and/or the players to reconfigure screen that display video content of game of chance (0050).

Giobbi further discloses a processor running the game and further discloses using local stored video content to provide reconfiguration to screens that display video content (0057).

Claims 8-9: Giobbi discloses a networked/centralized gaming system wherein the gaming system contains plurality of screens that display plurality of different games of chance (0009), with reconfiguring the machine in response to a reconfiguration command received from a remote location (title & 0001 & 0040).

Claim 10: Giobbi discloses the content of one of the screens/displays comprising the video content of an entire different game (0043).

Claim 11: Giobbi discloses a screen/display displaying a game being played by a player (0043) and further discloses a pay table capable of being accessed/displayed via a button (0036).

Claim 12: Marnell discloses video content comprising artwork representative of a theme of game played (col. 4: 10-29, wherein the game of poker is played and the artwork related to poker such as cards, are displayed on the display).

Claims 13, 30, 38, and 48-50: Marnell discloses a stand-alone gaming machine (col. 9:42-48), which includes a displays/screens displaying video content for a game of chance (col. 4: 17-29). However, Marnell is silent on the automatic reconfiguration happening in response to a trigger and also regarding multiple display devices. Giobbi teaches a gaming system in which video content is capable of being

Art Unit: 3714

reconfigured in response to various triggers such as time, play frequency (0050), wagered amount (0041& 0050) etc. Giobbi discloses a primary screen/display displaying a game being played by a player and a secondary screen/display displaying a secondary game play features (0043). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the feature of automatically reconfiguring the video content in response to a trigger as cited above as taught by Giobbi into the Marnell type system in order to provide automatic operation of reconfiguring display of subsequent gaming sessions, which would attract more players.

Response to Arguments

Applicant's arguments, see applicant submitted remarks, filed 3/17/2005, with respect to 35 U.S.C 112, first paragraph have been fully considered and are persuasive. The 35 U.S.C 112 Rejection for claims 8 and 46 has been withdrawn.

Applicant's arguments filed 3/17/2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to Hedrick reference are considered but are moot in view of the new ground(s) of rejection. The reference of Hedrick has been removed in response to the applicant's claim amendments.

The applicant argues that Giobbi reference teaches away from the claimed inventions by teaching of a game being executed on a server and then transmitted via a network connection to a terminal. The examiner respectfully disagrees with the applicant. Giobbi does teach of a gaming system that in which games are executed on

Art Unit: 3714

a server and then transmitted however Marnell teaches of storing games locally on the gaming machine (col. 2: 35-62) discloses plurality of games stored on the gaming machine, games such as slot, bingo, poker etc. are stored on the gaming machine itself, to eliminate network associated problems, related with network games.

In response to applicant's argument that Marnell is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant's invention falls within the field of gaming machines (slot machines, poker machines, etc) and Marnell does disclose a gaming machine that includes a stand-alone device to carry out the process in its system as mentioned above in the rejections.

In response to the applicant argument that Marnell reference has nothing to do with re-configurability of a gaming machine, the examiner would like to bring to the applicant's attention that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Thus the combination of Marnell and Giobbi disclose (1) a gaming machine containing plurality of different games of chance within the machine and (2) a gaming machine connected to a network, and (3) a gaming

Art Unit: 3714

system in which video content is capable of being reconfigured in response to various triggers such as time, play frequency (0050), wagered amount (0041& 0050) etc., and all of the limitations regarding the gaming machine disclosed within the applicant's claims.

Consequently, for the reasons given above the rejection is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 3714

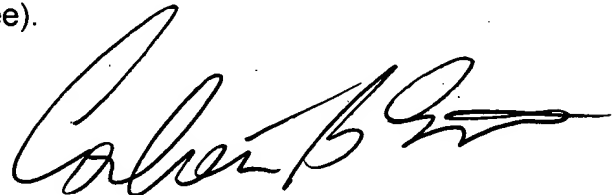
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunit Pandya whose telephone number is (571)272-2823. The examiner can normally be reached on M - F: 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571)272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SP



CORBETT B. COBURN
PRIMARY EXAMINER